

REMARKS

This Amendment is in response to the Office Action mailed May 9, 2003. Claims 1-6 and 8-28 were examined in the Office Action and all were rejected as obvious over the combination of Herrmann (U.S.P.N 5,995,756) and Peterson et al. (U.S. 2001/0003828 A1). Claim 28 was also objected to as being of improper dependent form.

Claim Objections

Claim 28 was objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 28 was also objected to due to an alleged informality relating to the reference to a "my documents" folder. Claim 28 has been amended to recite only two steps: (1) automatically reviewing a recently used document list; and (2) automatically reviewing a list of documents marked for use offline. These amendments streamline the dependent claim and address the objections raised in the Office Action.

Claim Rejections – 35 U.S.C. § 103

Claims 1-6 and 8-28 were objected to under 35 U.S.C. § 103(a) as being unpatentable over Herrmann (USPN 5,995,756) in view of Peterson et al. (US Publication No. 2001/0003828).

Initially, it is noted that the Peterson et al. application was recently issued (July 15, 2003) as U.S.P.N. 6,594,682. Furthermore, it is noted that the Peterson patent is assigned to Microsoft Corp., and that Microsoft is the assignee of the present application. Therefore, Peterson et al. cannot be cited in an obviousness rejection pursuant to 35 U.S.C. § 103(c).

Additionally, it is noted that the combination of Herrmann and Peterson et al. (even if such combination were proper) does not establish a prima facie case of obviousness. Indeed, such a prima facie case can only be met when **all** of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves (or in the knowledge available to those skilled in the art) to combine the references; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. In this case, there is no suggestion within the references themselves to combine the patents, nor would such a combination teach all of the

claim limitations. Specifically, the combination does not teach determining an application functionality required to execute a file on a local computer when the computer is disconnected from a network and (if necessary) transferring such application functionality to the local computer prior to disconnecting the local computer from the network.

For the above reasons, Applicant respectfully requests that the § 103(a) rejections be withdrawn and that the pending claims 1-6 and 8-28 be allowed.

Conclusion

It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: _____

8/7/03

CUSTOMER NO. 27488



Timothy B. Scull, Attorney Reg. No. 42,137
MERCHANT & GOULD P.
P. O. Box 2903
Minneapolis, MN 55402-0903
(303) 357-1648